

**REMARKS**

Claims 2, 3, and 5-22 are now pending in the above-captioned application.

Applicant notes with appreciation that the Examiner has indicated allowable subject matter.

**ALLOWABLE SUBJECT MATTER**

Claims 5, 6, 9, 15-19, 21, and 22 were indicated allowable if rewritten into independent form including the limitations of the base claim and any intervening claims.

By the above amendment, claims 5, 9, 10, 15, 18, 19, 21, and 22 have been placed into independent form. Claims 6, 16, and 17 depend upon or amended to depend upon, one of the allowed claims. **Thus, claims 5-6, 9, 10, 15-19, 21 and 22 are now clearly in condition for allowance.**

In addition, dependent claims 2-3, 7, 8, and 11 have been amended to depend from allowable claim 5. Claims 1 and 4 have been cancelled. Thus, applicant submits that all of the apparatus claims 2-3, and 5-11 are now in condition for allowance.

Method claims 13-14 and 20 have been amended to depend from allowed claim 15. Thus, applicant submits that method claims 13-22 are also in condition for allowance.

Method claim 12 remains the only claim in dispute.

**CLAIM OBJECTION**

Claims 1, 12, and 21 were objected to by the Examiner due to some minor errors. The above Amendment corrects these errors.

Claim 1 was objected to due to the definition of the size of the tube in relationship to the window track. The window track is recited in the preamble of the claim, but not as an element of the claim. Applicant respectfully disagrees with the Examiner's position on this objection.

In *CATALINA MARKETING INTERNATIONAL, INC., PLAINTIFF-APPELLANT, v. COOLSAVINGS.COM, INC.*, 289 F.3d 801, 62 U.S.P.Q.2d 1781, U.S. Court of Appeals, Federal Circuit, May 08, 2002, the Federal Circuit held that:

**In general, a preamble limits the invention if it recites essential structure or steps, or if it is "necessary to give life, meaning, and vitality" to the claim.**

*Pitney Bowes*, 182 F.3d at 1305. Conversely, a preamble is not limiting "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention." *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) (emphasis added).

Here, the court is clearly indicating that an element in the preamble can be used to give meaning to the claim. There is no prohibition of claiming the tube in relationship to the window track, or any requirement that the window track be made an element of the claim. Nor is the term indefinite. Window tracks are well known in the art, and are generally on the order of an inch to a few inches in width. Thus, the diameter of the tube is not undefined (e.g. it clearly cannot be 2 miles in diameter, or even 2 feet), but rather is limited to a size that will fit into a corresponding window track. It is hard to see how this limitation could be abused by applicant to cover an invention for something other than a tube for use in window track, or how the size range could not be clearly understood by one of ordinary skill in the art.

Note that while the preamble also cites an intended use for the apparatus, the limitation does more than merely cite intended use. By referencing the size of the tube relative to the window track, the window track size becomes an element of the invention.

The Examiner has indicated allowable subject matter in this application. In order to expedite prosecution of the allowed **apparatus** claims (the rejection was not applied to the method claims), applicant has deleted the reference to the window track in defining the diameter and length of the tube in the allowed claims.

With regard to the remaining claims, if the Examiner has an alternative recitation, which would overcome this objection, the Examiner is encouraged to call the undersigned at (703) 474-0757 to discuss the claim language. As allowable subject matter has been indicated, such a telephone interview would clearly expedite prosecution of the application.

**REJECTION UNDER 35 U.S.C. §112, Second Paragraph**

Claims 1, 11, 12, and 22 were rejected under 35 U.S.C. §112, second paragraph due to some minor informalities which have been corrected by the above amendment.

In claims 1, 11, 12, and 22, the term “substantially” was objected to as being indefinite. Applicant respectfully traverses this rejection.

The term “substantially” has been used in claim language for decades, and has been recognized by the courts as having a definite meaning. The Court of Appeals for the Federal Circuit in *Playtex Products, Inc. v. Proctor & Gamble Company*, 400 F.3d 901, 73 U.S.P.Q.2d 2010 (Fed. Cir. 03/07/2005) recently addressed this issue:

**"The term 'substantial' is a meaningful modifier implying 'approximate,' rather than 'perfect.'" *Liquid Dynamics*, 355 F.3d at 1368. But the definition of "substantially flattened surfaces" adopted by the district court introduces a numerical tolerance to the flatness of the gripping area surfaces of the claimed applicator. **That reading contradicts the recent precedent of this court, interpreting such terms of degree.** In *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1361 (Fed. Cir. 2003), **we refused to impose a precise numeric constraint on the term "substantially uniform thickness," noting that the proper interpretation of this term was "of largely or approximately uniform thickness" unless something in the prosecution history imposed the "clear and unmistakable disclaimer" needed for narrowing beyond this plain-****

**language interpretation.** Id. Moreover, in *Anchor Wall Sys. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298 (Fed. Cir. 2003), we held that "the phrase 'generally parallel' envisions some amount of deviation from exactly parallel," and that "**words of approximation, such as 'generally' and 'substantially,' are descriptive terms 'commonly used in patent claims 'to avoid a strict numerical boundary to the specified parameter.'"** Id. at 1311. In support of this holding, we noted that "nothing in the prosecution history [of the Anchor Wall patent]. . . clearly limit[ed] the scope of 'generally parallel' such that the adverb 'generally' does not broaden the meaning of parallel." Id. Similarly, in this case we find that in claiming "substantially flattened surfaces," Playtex claimed more than flat surfaces. (emphasis added).

Thus, the term "substantially" needs to be interpreted in light of the Specification. In the claims, the term "substantially" was used twice, once to define the diameter of the tube, and the other to define how the tube conforms to the track.

As noted above, the diameter of the tube is sized such that it is substantially the same as the width of the window track. If applicant were limited to a tube having a diameter exactly the same as the window track, a would-be infringer could make a tube slightly smaller or slightly smaller and avoid the claims of the present application. As the tube is flexible, it can be made slightly larger or smaller and still operate within the track by sealing the weep holes. One of ordinary skill in the art, reading the Specification can clearly understand this limitation and further understand the range of sizes involved.

In the second use of the term, the tube was defined as "substantially" conforming to the shape of the track. Upon reflection, it appears this description is not entirely accurate. When placed in the track, the bottom side of the tube substantially conforms to the shape of the track, whereas the top side may not. Thus, applicant has changed this language to read: "to fill and shape at least a portion of the tube to substantially conform to a shape of the window track". Applicant believes this more accurately describes the invention.

Again, if applicant were limited to a tube that shaped exactly to the shape of the track, the claim would not describe the preferred embodiment of the present invention. A cloth tube, for example, will not necessarily fill every crevice and crack in a complex extruded window track,

but will bridge most of these smaller areas. In this instance, the term “substantially” is wholly appropriate and definite as well.

Reconsideration of this portion of the 112 rejection is respectfully requested.

Claim 12 was rejected due to the use of the term “and the like” which has been deleted from the claim.

Claims 5 and 16 were also rejected due to an improper antecedent basis problem, which has been corrected as suggested by the Examiner. In reviewing the claims, applicant noted some claim dependency errors, which have been corrected by the above amendment.

#### **REJECTION UNDER 35 U.S.C. §102**

Claims 1-4, 7, 8, and 11 were rejected under 35 U.S.C. §102(b) as being anticipated by Gemmell. **This rejection has been rendered MOOT by the cancellation of claims 1 and 4. The remaining claims have been amended to be dependent from allowed claim 5.** Nevertheless, a discussion of this rejection is relevant.

In order to be complete, an anticipation-type rejection must contain two elements:

1. The reference must qualify as "Prior Art" under one of the sections of 35 U.S.C. §102;
- and
2. The reference must explicitly teach *ALL* of the features of the claimed invention.

Gemmell has an effective date more than one year prior to applicant's filing date.

Gemmell discloses the type of draft stop known in the art. These types of draft-stoppers for doors have been in use since colonial times, and enjoyed a brief resurgence during the energy crises of the 1970's. Gemmell's particular point of novelty appears to be his method of attaching the device to the bottom of the door, using two knobs that pass under the door.

As noted in the description of the present application, the present application is not a draft-stopper. In fact, it is just the opposite – it allows the user to leave a screened window open (letting a draft IN) while blocking the ingress of insects and the like through the window weep holes. The difference is more than trivial.

Modern aluminum and plastic-framed windows rely upon inexpensive extrusion technology to form window frame components. These windows, particularly the plastic variety, are very durable, never need painting, do not stick, jam, or corrode, and are also very easy to clean, as they pivot for easy cleaning. As a result, such plastic framed windows have taken a huge share of the market, outselling aluminum and wood framed windows in most instances.

However, extruded frame windows generally have a channel formed at the sill for structural and sealing purposes. To prevent rain and water from accumulating in this track, weep holes are formed in the channel or frame. Flaps may cover these holes. Even with the flaps, however, the weep holes allow insects to ingress, as the undersigned has observed directly.

Applicant realized that a removable device was needed to block these weep holes if a user was to open the house windows regularly and rely upon the screens to keep insects out. Caps, covers, or other fit-specific devices would have to be manufactured to fit individual windows and might require installation and removal with tools. The solution applicant has conceived is to use a flexible tube filled with a material such that the tube can be placed in the window sill blocking the weep holes, preventing insect ingress. The apparatus is cheap, easy to use, fits a number of different sized windows, requires no special tools, and can be removed and re-used over and over again.

The Gemmell reference has been applied only to the apparatus claims, a clear admission that Gemmell does not teach or suggest the concept of using a filled tube to block the weep holes in a window. Thus, it is clear that applicant's invention is neither taught nor suggested by the Prior Art of record, and thus Gemmell does not teach all of the features of applicant's claimed invention.

However, in the interests of advancing prosecution of the present application, the rejected apparatus claim 1 has been cancelled without prejudice toward presenting such claims in a

Divisional Application. The remaining dependent apparatus claims have been amended to be dependent upon allowed claim 5, either directly or indirectly.

Claims 12 and 20 were rejected under 35 U.S.C. §102(a) as being anticipated by Brown. **A portion of this rejection has been rendered MOOT, as claim 20 has been amended to be dependent from allowed claim 16.** Thus only claim 12 remains in dispute.

In order to be complete, an anticipation-type rejection must contain two elements:

1. The reference must qualify as "Prior Art" under one of the sections of 35 U.S.C. §102;
- and
2. The reference must explicitly teach *ALL* of the features of the claimed invention.

In this instance, the Brown reference has an effective date of June 18, 2002, less than one year prior to Applicant's provisional filing date of November 13, 2002. It is possible that applicant can swear behind this reference if applied to a rejection in a future application. However, since the rejection is moot, such an affidavit is not necessary at this time.

However, Brown teaches little more than Gemmell. In particular, Brown teaches *excluding drafts* between the sashes of a double-hung window. The present invention, in contrast, is directed toward *allowing drafts* through a screen while preventing insect intrusion. Moreover, the present invention is directed toward sealing insect weep holes and not toward sealing between sashes.

Thus, not only do Brown and Gemmell not teach the claimed invention, their motivation toward draft sealing makes the present invention non-obvious in view of these references. A person of ordinary skill in the art would not be motivated to use a draft-sealing device to prevent insect intrusion.

Claim 12, as amended, recites the step of:

“... placing the filled tube that is placed in the window track to seal the window track weep holes to prevent pests from intruding into the interior of a building through the window track weep holes.”

The Examiner argues that the method step of sealing weep holes is merely a statement of intended use and therefore should not be given any weight. While such a statement may hold some weight in an *apparatus* claim, (See *Catalina Marketing*, cited above), it is wholly inappropriate in the analysis of a method claim. A method claim comprises a series of steps. To ignore one of the steps as “intended use” would allow an Examiner to disregard any step in the claim at whim.

The reason this “intended use” of a method claim argument is raised is plain and clear. The Examiner cannot find any reference teaching Applicant’s invention. This is not due to any failing on the part of the Examiner, but rather because Applicant’s invention is novel and non-obvious. In such instances, allowance of the claim is the indicated remedy.

Thus, applicant respectfully requests that the 102 rejection of claim 12 be withdrawn and the application passed to issue.

#### **REJECTION UNDER 35 U.S.C. §103**

Claims 13-14 were rejected under 35 U.S.C. §103 as being unpatentable in view of Brown. Applicant respectfully traverses this rejection. **This rejection has been rendered MOOT, as claims 13-14 are now dependent upon allowed claim 15.**

**CONCLUSION**

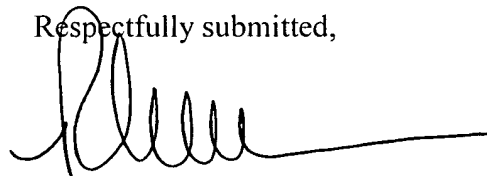
Claims 5, 6, 9, 15-19, 21, and 22 were indicated allowable if rewritten into independent form including the limitations of the base claim and any intervening claims. By the above amendment, claims 5, 9, 10, 15, 18, 19, 21, and 22 have been placed into independent form. Claims 6, 16, and 17 depend upon or amended to depend upon, one of the allowed claims. In addition, dependent claims 2-3, 7, 8, and 11 have been amended to depend from allowable claim 5. Claims 1 and 4 have been cancelled. Method claims 13-14 and 20 have been amended to depend from allowed claim 15. **Thus, claims 2-3, 5-11, and 13-22 are now clearly in condition for allowance.**

Method claim 12 remains the only claim in dispute. This claim was rejected under 35 USC 102(a) on the grounds that one of the recited method steps comprises "intended use" and therefore "functional language". As a method claim by its nature describes as series of functions and uses, this type of rejection is improper and should be withdrawn.

Thus, all of claims 2-3, and 5-22 are now in condition for allowance.

An early Notice of Allowance is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Bell', with a long horizontal flourish extending to the right.

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